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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/023,438	12/18/2001	Niko Eiden	944-003.123	2313

7590 03/23/2006

Ware, Fressola,
Van Der Sluys & Adolphson LLP
755 Main Street
P.O. Box 224
Monroe, CT 06468

EXAMINER

NGUYEN, DAVID Q

ART UNIT PAPER NUMBER

2617

DATE MAILED: 03/23/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/023,438

Applicant(s)

EIDEN ET AL.

Examiner

David Q. Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 January 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 2-11 and 13-16 is/are allowed.
- 6) ☒ Claim(s) 1, 12 and 17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 17 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. "A free-to-edit-and-free-to-not-edit tag" claimed in the claim 15 is not described in the specification. The specification only describes "a free-to-edit tag or a not-free-to-edit tag". "A free-to-edit-and-free-to-not-edit tag" is different from "a free-to-edit tag or a not-free-to-edit tag". Moreover, "A free-to-edit-and-free-to-not-edit tag" is unclear.

Response to Arguments

2. Applicant's arguments filed 01/27/06 have been fully considered but they are not persuasive.

In response to applicant's Remarks on page 7, applicants argue: "Feldis specifically states that if the "field does not contain any tag, then . . . the user may edit" (see par. 38 of Feldis). Feldis thus teaches away from present claims 1 and 12, which both say that the user can edit the picture "only if the free-to-edit-tag is included in the picture."

Examiner respectfully disagrees because in par. 38 of Feldis, Feldis teaches that user may edit or perform other functions on the image data 184 using **input device 212**. The input device 212 is not **the computer 200 (a wireless terminal)**. Fig. 2 shows that the input device 212 is connected to the computer 200. So, user cannot enable editing pictures on the computer 200. User only enables editing picture using another device (the input device 212). The claimed invention of the application is user enables editing pictures **on a wireless terminal** only if the free-to-edit tag included in the picture. Therefore, Feldis does teach the present claims 1 and 12.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1 and 12 are rejected under 35 U.S.C. 102(e) as being anticipated by Feldis, III (US 2003/0007078 A1).

Regarding claims 1 and 12, Feldis III discloses a wireless terminal for communicating pictures via a wireless communication system (see par. 0028) and a method, the wireless terminal comprising: a picture manager (CPU 206; fig. 2) responsive to signals indicating pictures for displaying the pictures each of which is editable if free-to-edit tag embedded in the picture (see par. 0032-0034 and fig. 2), for examining each of the pictures to determine whether each of the pictures includes the free-to-edit tag so as to be editable thus allowing a user to alter

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the content of at least a portion of the picture (see par. 0034), and for enabling editing of each of the pictures received by the user only if the free-to-edit tag is included in the picture received by the user (see par. 0032-0034 and fig. 2); and a picture source, for providing the signals indicating pictures (see fig. 2).

Allowable Subject Matter

4. Claims 2-11 and 13-16 are allowed.

The following is an examiner's statement of reasons for allowance: ***.

Regarding independent claim 5, the claim has been rewritten as an independent form including all of the limitations of the base claim. Therefore, claim 5 is now allowable with the same reason set forth in the previous office action.

Regarding independent claim 16, the claim has been rewritten as an independent form including all of the limitations of the base claim. Therefore, claim 16 is now allowable with the same reason set forth in the previous office action.

Claims 2-4 and 6-11 depend on claim 5. Therefore, they are allowable

Claims 13-15 depend on claim 16. Therefore, they are allowable.

Conclusion

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Q. Nguyen whose telephone number is 571-272-7844. The examiner can normally be reached on 8:30AM-5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, JOSEPH H. FEILD can be reached on (571)272-4090. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


David Nguyen


ERIKA A. GARY
PRIMARY EXAMINER